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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Patent Application of |) | |
| Augustin J. Farrugia et al. |) | Group Art Unit: 2157 |
| Application No.: 09/975,994 |) | Examiner: Moustafa M. Meky |
| Filed: October 15, 2001 |) | Confirmation No.: 9558 |
| For: DEPLOYMENT OF SMART CARD |) | |
| BASED APPLICATIONS VIA |) | |
| MOBILE TERMINALS |) | |

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated December 30, 2004, Applicants respectfully requests reconsideration and withdrawal of the rejection of claims 1-5 and 16-24. The allowance of claims 6-15 and 25-33 is noted with appreciation.

Claims 1-5 and 16-24 were rejected under 35 U.S.C. §102, on the grounds that they were considered to be anticipated by the *Sashihara* patent (U.S. Patent No. 6,434,405). This patent discloses a transmitting and receiving card that can be selectively attached to each of a portable phone and an information terminal. The background portion of the patent describes the prior state of the art, in which a portable phone and a portable information terminal were connected to each other, for example by means of a cable, to enable the portable information terminal to transmit and receive e-mail. The patent goes on to point out that the need to connect these two devices to one another diminishes their ease of transportability. To overcome this problem, the patent describes a transmitting and receiving card that, in essence, functions as a form of removable memory that can be selectively connected to the

portable phone or the information terminal. In operation, the card is first connected to the portable phone, to receive information via a wireless connection, e.g. e-mail or web pages. Thereafter, the card is removed from the phone, and connected to the information terminal, where the e-mail or web pages can be displayed. This transportable form of memory removes the need to physically connect the portable phone and the information terminal to one another.

The present invention is directed to an objective that is entirely different from the problem addressed by the *Sashihara* patent. Specifically, the claimed invention provides a user with the ability to access a smart card based Internet application, e.g. an electronic purse, in those situations where the user does not have current access to a conventional reader for a conventional smart card that interacts with the application. In accordance with one aspect of the invention, as set forth in claims 1-5 and 16-24, a smart card that is designed for use with a particular device is provided with additional functionality, so that it can also be used to access the smart card based Internet application. An example of such a card is a SIM card that is designed for use with a portable telephone. As described in the specification, for example at page 3, a conventional SIM card stores information such as a subscriber identification number, security information and a personal directory of numbers, and enables the subscriber to send and receive telephone calls from any device that supports the card, e.g. a GSM telephone. In accordance with the claimed feature of the invention, such a card is also provided with information that enables the device to establish an Internet session with the Internet-accessible smart card based application. Thus, the card possesses dual functionality, e.g. the normal functions of

a SIM card to place and receive calls with a GSM device, and the additional ability to interact with the smart card based application via the device.

It is respectfully submitted that the claimed subject matter differs from the disclosure of the *Sashihara* patent in a number of aspects. First, the *Sashihara* patent is not concerned with smart card based applications, particularly those that are accessible via the Internet. While the patent discloses that its transmitting and receiving card can be used to obtain information via the Internet, such as e-mails, web pages or data base records, it does not disclose that these applications employ the features of a smart card, e.g. security protocols, user profile information, etc., to provide such information. As noted above, the objective of the present invention is to provide a smart card holder with the ability to access a smart card based application when a conventional smart card reader is not available. The *Sashihara* patent does not disclose any concern for this problem, or a solution thereto.

Furthermore, even if the Internet-accessible applications described in the *Sashihara* patent could be modified to interact with smart cards, such a modified interpretation of the reference still would not suggest the claimed subject matter. Claim 1 recites a smart card having two types of information stored therein. The first type of information is that which is dedicated to the functionality of the device with which the smart card is adapted to be used. For instance, in the example of a SIM card, such a card contains information that is dedicated to the telephony functions of a wireless telephone. The claim goes on to recite that the card includes additional information that enables the device to establish an Internet session with an Internet-accessible application and that functions as an interface to that application. It is respectfully submitted that the *Sashihara* patent does not disclose a smart card

having both of these types of information stored thereon. At best, the transmitting and receiving card of the *Sashihara* patent only contains the second type of information, namely that which enables it to establish an internet session with an e-mail server or http server, and function as an interface thereto. The *Sashihara* patent does not disclose that the transmitting and receiving card also contains information that is dedicated to the functionality of the portable phone, e.g. in the nature of a SIM card. All of the information stored on the transmitting and receiving card is directed to the ability to transmit and receive e-mail or web pages. There is no disclosure suggesting that the card also contains information that deals with the user's ability to place or receive telephone calls via the portable phone. If anything, the patent suggests that the portable phone can be used for such a purpose independently of the transmitting and receiving card. The card's only purpose is to transfer data to and from the information terminal, for processing. It is not a functional part of the phone.

Accordingly, it is respectfully submitted that the *Sashihara* patent does not disclose the subject matter of claim 1, for at least the foregoing reasons. For similar reasons, it is respectfully submitted that the subject matter of claims 16 and 20 is likewise not anticipated by the reference.

Furthermore, claims 4, 18 and 23 specifically recite that the smart card is a subscriber identification module, i.e. a SIM. In rejecting these claims, the Office Action alleges that the transmitting and receiving card of the *Sashihara* patent is a SIM, because it is used with a portable phone. However, the mere fact that the card is used with a portable phone does not inherently make it a SIM. As noted previously, a SIM is a card that securely stores information such as a subscriber's


identification number, security information and a personal directory of numbers, and enables a user to make calls with a GSM phone. See the definitions of "SIM" and "SIM Card" from the pages of Newton's Telecom Dictionary being submitted herewith. There is no disclosure in the *Sashihara* patent suggesting that the transmitting and receiving card stores any of the types of information, or performs any of the functions, associated with a SIM card. For this additional reason, therefore, it is respectfully submitted that the subject matter of claims 4, 18 and 23 is not anticipated by the *Sashihara* patent.

In view of the foregoing, it is respectfully submitted that all pending claims are patentably distinct from the *Sashihara* patent. Reconsideration and withdrawal of the rejection is respectfully requested.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By: 
James A. LaBarre
Registration No. 28,632

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620